



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) | |
|--|--|--|------------------|
| <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p> | | Application Number | Filed |
| | | 10/660,754 | Sept. 12, 2003 |
| | | First Named Inventor Komeyama, et al. | |
| | | Art Unit | Examiner |
| | | 3679 | Gregory J. Binda |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 39,715 Registration number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p> | | | |

Signature
James E. Howard, Esq.
Typed or printed name
(703) 761-4100
Telephone number
10/3/05
Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Komeyama et al.

Serial No.: 10/660,754

Group Art Unit: 3679

Filed: September 12, 2003

Examiner: Gregory John Binda

For: CROSS JOINT

Honorable Commissioner of Patents

Box AF

Alexandria, VA 22313 - 1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This paper is a Pre-Appeal Brief Request for Review.

Applicants request for panel review is based upon clear legal and factual deficiencies in the rejections of record.

In particular, the rejections include a clear legal error for failing to provide patentable weight to the distinctive structural characteristics that are imparted as a result of the process by which the claimed product is made. Clearly, this is contrary to U.S. Patent Law and presents a clear legal deficiency with the rejections.

Applicants respectfully refer the panel to pages 15-16 of the September 1, 2005 Amendment Under C.F.R. § 1.116 for the full traversal regarding the failure to provide patentable weight to the distinctive structural characteristics that are imparted as a result of the process by which the claimed product is made and also to Section 2113 of the Manual of Patent Examining Procedure.

On September 19, 2005, Applicants' representative contacted the Examiner in response to the September 14, 2005, Advisory Action. Applicants noted that the Advisory

Action indicated that the September 1, 2005, Amendment was entered and that the 35 U.S.C. § 112 rejections had been withdrawn. However, Applicants also noted that the Advisory Action also indicated that the Examiner continued to reject the claims, but the Advisory Action did not include any explanation as to why the Amendment failed to place the application into condition for allowance. Therefore, the Applicants' representative contacted the Examiner to obtain an explanation as to the continued rejection.

During the telephone conference, Examiner Binda confirmed that he did not provide patentable weight to the language of the product-by-process claims. The Examiner did not provide any response to the Applicants traversal regarding the failure by the Examiner to provide patentable weight to the distinctive structural characteristics that are imparted as a result of the process by which the claimed product is made as is required by M.P.E.P. § 2113.

Rather, Examiner Binda simply alleged that product-by-process claims are not patentable.

Applicants respectfully submit that the failure to provide patentable weight to the distinctive structural characteristics that are imparted as a result of the process by which the claimed product is made as is required by U.S. Patent Law and as explained at section 2113 of the M.P.E.P. is a clear legal error.

Further, Applicants respectfully submit that in view of the above-described clear legal error, the rejections also include clear factual deficiencies. Specifically, the rejections fail to provide a *prima facie* rejection by failing to identify the presence of claimed elements in the applied references.

In particular, as explained in the remarks of the September 1, 2005, Amendment, to which Applicants respectfully refer the review panel, none of the applied references teaches

or suggests the features of the claimed invention including: 1) shoulder portions that are subjected to roller burnishing (claim 1); and 2) a roller burnished shoulder (claim 16). This feature is important for extending the life of the cross joint by increasing the fatigue strength, the hardness of the surface, and the residual compressive stress of the shoulders by roller burnishing the shoulder.

More particularly as pointed out by the Remarks in the September 1, 2005, Amendment, which are incorporated herein in their entirety, the Examiner does not allege that the Gall reference discloses shoulder portions that are subjected to roller burnishing as recited by the independent claims.

Further, the Examiner does not allege that any of the Laster reference, the Ostrovsky et al. reference, or the Laughlin reference teaches doing anything at all to the shoulders, let alone roller burnishing the shoulders.

The failure of the Examiner to allege that any of the applied references teaches or suggests the features of the claimed invention including: 1) shoulder portions that are subjected to roller burnishing (claim 1); and 2) a roller burnished shoulder (claim 16) evidences a clear failure to establish a *prima facie* rejection.

Therefore, Applicants respectfully submit that the rejections include clear legal and factual deficiencies.

In view of the foregoing, Applicants respectfully submit that claims 1-4, 7-8, 11-14, 16-26, 29-32, and 34-37, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Review Panel and/or the Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Docket No. K06-161131M/TBS
Serial No. 10/660,754

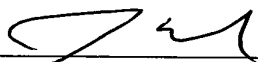
4

Should the Review Panel and/or the Examiner find the Application to be other than in condition for allowance, the Review Panel and/or the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 10/3/05


James E. Howard
Registration No. 39,715

McGinn Intellectual Property Law Group, PLLC
8321 Old Courthouse Rd., Suite 200
Vienna, Virginia 22182
(703) 761-4100
Customer No. 21254